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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,552	11/26/2003	Jay A. Fishman	14846-011004 / MGH 0978-2	9739
26161	7590	11/03/2006	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			CARLSON, KAREN C	
			ART UNIT	PAPER NUMBER
			1656	

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/723,552

Applicant(s)

FISHMAN, JAY A.

Examiner

Karen Cochrane Carlson, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-23, 25, 26 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1(c), 6, 8(g-i), 15-17, 18(c), 23, 24, and 26 (c) is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 1 (a, b), 2-5, 8(a-f), 9-14, 18(a, b), 19-22, 25, and 26 (a, b) .

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This Office Action is in response to the paper filed September 6, 2006.

Claims 7 and 24 have been cancelled. Claims 1 (a, b), 2-5, 8(a-f), 9-14, 18(a, b), 19-22, 25, and 26 (a, b) have been withdrawn from further consideration by the Examiner because these claims are drawn to non-elected inventions. Claims 1(c), 6, 8(g-i), 15-17, 18(c), 23, 24, and 26 (c) are currently under examination.

Priority is set to the filing date of SN 08/766,528, December 13, 1996. The instant SEQ ID NO: 3 is not found in SN 08/572,645 filed December 14, 1995. Rather, '645 teaches instant SEQ ID NO: 1 encoding Tsukuba-1.

**Withdrawal of Objections and Rejections:**

The objection to the disclosure because the priority information must be updated to include patent numbers on page 1 of the specification, is withdrawn.

The rejection of Claims 1(e, f), 6, 7, 8(g-l), 15-17, 18(e, f), 23, 24, and 26 (e, f) under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, is withdrawn.

The rejection of Claims 1f, 7, 18 (e, f), 23, 24, and 26f under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility, is withdrawn.

The rejection of Claims 18(e), 23, and 26(e) are rejected under 35 U.S.C. 102(b) as being anticipated by Hayashi et al. 1992. J. Immunol. 149:1223-1229, is withdrawn.

**Maintenance of Rejections:**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 1(c), 6, 8(g-i), 15-17, 18(c), 23, and 26 (c) are again rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

The polypeptide encoded by a nucleic acid comprising the nucleotide sequence SEQ ID NO: 3 lacks a specific utility. First, SEQ ID NO: 3 encodes at least 3 different proteins, gag, pol, and env. Review articles in the retroviral art teach that gag is further cleaved into at least matrix (MA), Capsid (CA), and nucleocapsid (NC) (Freed, 2002; J. Virol. 76 (10): 4679-4687; see Fig. 1 for "Generic Gag"). Pol is cleaved into enzymes, and Env cleaved into glycoproteins. In the genome, Gag is further cleaved into p1, p2, and p6. The pol is cleaved into enzymes HIV-1 protease (PR), reverse transcriptase (RT), and integrase (IN), while the env is cleaved into vpu, surface (SU), and transmembrane (TM) envelope proteins (Freed, 1998; Virol. 251:1-15, see Fig. 1A). Besides gag, pol, and env, the HIV-1 genome encodes additional proteins, such as vif, vpr, and nef (Freed, 1998). As in HIV-1, Freed (2002) teaches that gag encodes proteins other than MA, CA, and NC. In mouse leukemia virus (MLV), gag additionally comprises p12; in Rouse sarcoma virus, p2a, p2b, and p10; in Mason-Pfizer monkey virus (M-PMV), p4, p12, and pp24/16; and in equine infectious anemia virus (EIAV), p9. The instant specification is silent as to the function and proteolytic breakdown of polypeptides encoded by SEQ ID NO: 3, having at least 85% identity to SEQ ID NO: 3, or having at least 30 or 100 nucleotides from SEQ ID NO: 3. Indeed, no polypeptides or polypeptides sequences are taught in the specification.

Additionally, human immunodeficiency virus (HIV-1) proteins result in reduced immune system function, the mouse leukemia virus (MLV) proteins result in leukemia, the Rouse sarcoma virus proteins result in cancer, and the equine infectious anemia virus (EIAV) proteins result in anemia, for example. The instant specification is silent regarding the function of proteins encoded by SEQ ID NO: 3, having at least 85% identity to SEQ ID NO: 3, or having at least 30 or 100 nucleotides from SEQ ID NO: 3. Aliyoshi et al. (with inventor Jay Fishman); 1998; J. Virol. 72(5): 4503-4507) teach a retrovirus having 99.9 % identity to SEQ ID NO: 3 (5 mismatches), and

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encoding the env protein (Fig. 1). Other encoded proteins are not disclosed therein. At page 4503, left col., para. 2, Akiyoshi et al. teach that Type C retroviruses from swine cell lines are known but no disease following infection has been identified.

Therefore, it can be concluded that the polypeptide(s) encoded by SEQ ID NO: 3, having at least 85% identity to SEQ ID NO: 3, or having at least 30 or 100 nucleotides from SEQ ID NO: 3 do not have a specific utility.

The polypeptides have not been taught to have a substantial utility, or real world use. While SEQ ID NO: 3 (having at least 85% identity to SEQ ID NO: 3, or having at least 30 or 100 nucleotides from SEQ ID NO: 3) may be a retrovirus, the specification does not teach the function of the encoded proteins. Thus, one skilled in the art would have to carry out further research to identify the use of these encoded polypeptides.

The specification does not assert any utility for the encoded polypeptides; thus, the polypeptides lack credible utility because no utility is offered.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1(c), 6, 8(g-i), 15-17, 18(c), 23, and 26 (c) are also again rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific, substantial, credible, or operable, asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

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At pages 9-10 of their response, Applicants urge that the specification teaches methods and reagents for detecting porcine retroviruses that are useful for screening donor animals and xenografts recipients to determine infection and as a measure of the appropriate level of immune suppression. Further these methods include ELISA based assays which include generating the porcine retroviral polypeptides and generating antibodies against these polypeptides to perform the ELISA.

This argument is not persuasive because this is a "reach through" utility, that is, one must make all of the polypeptides encoded by SEQ ID NO: 3, make all of the antibodies specific to these polypeptides, then determine for themselves if the detection of these polypeptides has any bearing on xenograft transfer. It is not for another to arrive at Applicant's invention. As noted, many polypeptides are encoded by SEQ ID NO: 3. Applicants have not provided a function for any of these polypeptides. These polypeptides differ from prostate specific antigen (PSA), for example, where the detection of PSA is an indicator of prostate cancer. Thus, using ELISA to detect the claimed polypeptides is tantamount to isolating the polypeptide, which is a circular utility. In the instantly claimed invention, the polypeptides are not in hand and no function is provided for these polypeptides. One cannot know until they determine for themselves if detection of any one of the polypeptides will be an indication that a donor animal will pass the nucleic acid retroviral vector to the xenograft recipient and cause deleterious effects. Thus, the polypeptides encoded by SEQ ID NO: 3 lack a specific utility.

Claims 1(c), 6, 8(g-i), 15-17, 18(c), 23, and 26 (c) are again rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The specification and claims do not set forth any structure of or function for the claimed polypeptides encoded by SEQ ID NO: 3, having at least 85% identity to SEQ ID NO: 3, or having at least 30 or 100 nucleotides from SEQ ID NO: 3. Also, this polypeptide is not in hand. Therefore, the specification lacks written description for the claimed polypeptide(s).

Applicants urge at page 13 of their response that the determination of polypeptide sequences encoded by a given nucleic acid sequence is well within the capabilities of skilled artisans and that polypeptide sequences are disclosed in Figure 3.

The argument is not persuasive because there is no correlation of structure with function. Therefore, one skilled in the art could not determine which polypeptides fall within the claimed invention, that is, polypeptides encoded by a polynucleotide having at least 85% identity to SEQ ID NO: 3 may have activities other than full-length polypeptides encoded by SEQ ID NO: 3, which polypeptides have no disclosed functions.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1(c), 6, 8(g-i), 15-17, 18(c), 23, and 26 (c) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims refer to "A polypeptide..." As noted above in the rejection under 35 USC 101, retroviruses encode many polypeptides; therefore, it is not clear which polypeptide is being claimed.



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Claim 1 refers to "85% identical". The term "identical" is an absolute term, meaning that one thing is identical to another or it is not. Thus, one skilled in the art cannot know what a fraction of identical means.

Claim 18 f refers to "70% homology". The term "homology" is a qualitative term and not a quantitative term. Thus, one skilled in the art cannot know what 70% homology means. Additionally, it is not clear what a corresponding human, , mouse, or primate retrovirus sequence is, or the last five 3' bases may be.

Additionally, the claims still continue to comprise inventions drawn to non-elected subject matter. Therefore, the Claims are indefinite because they do not particularly point out and distinctly claim the subject matter which the applicant regards as his elected invention.

**Additionally**, in newly amended Claim 18, reference to SEQ ID NO: 3 is not preceeded by "(c)".

Applicants urge that the fact that a nucleotide sequence such as SEQ ID NO: 3 encodes multiple polypeptides does not render the claims indefinite, and that identifying open reading frames in a DNA sequence is within the capabilities of one of ordinary skill. Again, it is not for another to determine the meets and bounds of Applicants' claimed polypeptides. Therefore, reference to a polypeptide encoded by SEQ ID NO: 3 is indefinite.

Applicants urge that the use of the term "identical" is commonly used in the art to describe the degree of similarity between sequences. The term "identical" is not used to describe similarity, because one thing is identical to another or it is not. Thus, this aspect of the rejection is maintained.

Applicants urge that the term "homology" is known in the art. The Examiner agrees; it is not clear what the quantitation of "70% homology" means.

Applicants have not addressed the issue of having non-elected inventions within the claims.

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**New Objections:**

The disclosure is objected to because of the following informalities:

Applicants have not provided the sequences depicted in the drawings in the Sequence Listing. Applicants must provide a new Sequence Listing and computer readable form (CRF) of the sequences to comply with the Sequence Rules.

Appropriate correction is required.

No Claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 571-272-0946. The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Kathleen Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**KAREN COCHRANE CARLSON, PH.D**  
**PRIMARY EXAMINER**